| | | | | |
|---|---|---|---|---|
| Appl. No. | : | 09/774,968 | Confirmation No. | 6029 |
| Applicant | : | Zebian | | |
| Filed | : | 01/31/2001 | | |
| TC/A.U. | : | 2154 | | |
| Examiner | : | Patel | | |
| Docket No. | : | U000-P02026US | | |
| Customer No. | : | 33356 | | |

Mail Stop Appeal Brief- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

## SUBSTITUTE APPEAL BRIEF

Dear Sir:

The following substitute Appeal Brief is submitted pursuant to the Notification of Non-Compliant Appeal Brief mailed June 18, 2007. The following substitute Appeal Brief is submitted pursuant to 37 C.F.R. § 41.37(c) for consideration by the Board of Appeals and Interferences.

## (i) REAL PARTY IN INTEREST

The real party in interest is NetZero, Inc.

## (ii) RELATED APPEALS AND INTERFERENCES

There are no applications currently being appealed that may directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

## (iii) STATUS OF CLAIMS

Claims 1-40 were pending and rejected in the Final Office Action dated 09/08/2004. Claims 26-29 and 33-40 were cancelled via an amendment dated 12/10/2004. Claims 1-25 and 30-32 are pending and are the subject of this appeal.

## (iv) STATUS OF AMENDMENTS

An amendment canceling claims 26-29 and 33-40 was filed on 12/10/2004.

## (v) SUMMARY OF CLAIMED SUBJECT MATTER

### *Independent Claim 1:*

A method for maximizing qualities of a user network access number (NAN) list (p. 16, ll. 3-4; FIG. 2, 200-260), the user NAN list comprising plural NANs (p. 17, ll. 11-12; FIG. 2, 240), the NANs for use by a user's client device (p. 11, ll. 5-6; FIG. 1, 110) in connecting to a data network under control of a server system (p. 10, ll. 15-16; FIG. 1, 160), the method comprising: storing in the server system an available NAN list of NANs available for the client device to connect to the data network, wherein the user NAN list comprises a subset of the available NAN list (p. 11, ll. 13-17; FIG. 1, 121-124); storing in the server system connection information about connecting from the NANs in the available NAN list to the data network (p. 16, ll. 7-10; FIG. 2, 215); connecting the client device to the server system (p. 17, ll. 3-4; FIG. 2, 220); setting the NANs in the user NAN list

based upon the available NAN list (p. 17, ll. 7-8; FIG. 2, 230); setting an order for selecting the NANs in the user NAN list based upon the connection information (p. 17, ll. 15-17; FIG. 2, 240), wherein the order is set outside of the user's control (p. 17, ll. 17-18); disconnecting the client device from the server system (p. 19, l. 17; FIG. 2, 250).

### *Independent Claim 12:*

A method of setting an order for using network access numbers (NANs) in a user NAN list (p. 17, ll. 15-17; FIG. 2, 240), the user NAN list comprising plural NANs (p. 17, ll. 11-12), the NANs for use by the user's client device (p. 11, ll. 5-6; FIG. 1, 110) in connecting to a data network under control of an online service provider server system (p. 10, ll. 15-16; FIG. 1, 120), wherein a connection from the client device to the data network comprises a front end portion and a back end portion (p. 10, ll. 11-14; FIG. 1, 180, 190), the front end portion comprising a first connection from the client device to a public switch (p. 14, ll. 5-6; FIG. 1, 130), and the back end portion comprising a second connection from the public switch to a point of presence under control of one of plural back end providers plus a third connection from the point of presence to the data network (p. 14, ll. 16-21, p. 15, ll. 1-6; FIG. 1, 130, 140, 150, 160), wherein authorization for the back end provider to establish the back end portion is by the online service provider server system (p. 15, ll. 6-9; FIG. 1, 120, 130, 140, 150, 160), and each NAN is associated with one of the back end providers (p. 14, ll. 19-21; FIG. 1, 130, 140, 150, 160, 190), the method comprising: storing in the online service provider server system an available NAN list of NANs available for the user's client device to connect to the data network, wherein the user NAN list comprises a subset of the available NAN list (p. 11, ll. 13-17; FIG. 1, 121-124); storing in the online service provider server system connection information for connecting from the NANs in the available NAN list to the data network (p. 16, ll. 7-10; FIG. 2, 215), the connection information comprising at least one of (a) quality of connection information for the back end portion and (b) costs information for the back end portion (p. 15, ll. 17-19; FIG. 1, 122); establishing a connection from the client device to the online service provider server system (p. 17, ll. 3-4; FIG. 2, 220); transmitting an identification of the NANs in the user NAN list from the client device to the online service provider server system (p. 20, line 21 – p. 21,

line 2; FIG. 1, 110, 120); setting an order for selecting the NANs in the user NAN list based upon at least one of (a) the stored quality of connection information for the back end portion and (b) costs information for the back end portion (p. 19, ll. 12-13; FIG. 1, 121, 122).

### *Independent Claim 30:*

An online service provider server system for controlling a connection between a user's client device and a data network (p. 10, ll. 15-16, p. 11, ll. 5-6; FIG. 1, 110, 120), wherein the user's client device attempts connection to the data network using network access numbers in a user network access number (NAN) list comprising plural NANs (p. 10, ll. 15-16, p. 11, ll. 5-6, p. 17, ll. 11-12; Fig. 1 110, 160; FIG. 2, 240), the online service provider server system comprising: a first memory storing an available NAN list of NANs available for the client device to connect to the data network, wherein the user NAN list comprises a subset of the available NAN list (p. 11, ll. 2-3 and 13-17; FIG. 1, 113 and 121-124); a second memory storing connection information about connecting from the NANs in the available NAN list to the data network (p. 11, ll. 2-3, p. 16, ll. 7-10; FIG. 1, 113; FIG. 2, 215); computer program code which when executed causes the online service provider server system to perform operations including (p. 6, ll. 6-7, p. 15, ll. 12-14; FIG. 1, 110, 120, 140 and 150) connecting to the user's client device (p. 17, ll. 3-4; FIG. 2, 220); setting the NANs in the user NAN list based upon the available NAN list (p. 17, ll. 3-4; FIG. 2, 220); setting an order for selecting the NANs in the user NAN list based upon the connection information (p. 19, ll. 12-13; FIG. 1, 121, 122), wherein the order is set outside of the user's control (p. 17, ll. 17-18); disconnecting from the client device (p. 19, l. 17; FIG. 2, 250).

## (vi) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-11 were rejected under 35 U.S.C. § 102(e) as being anticipated by West et al. (USP 6,081,508).

Claims 12-40 were rejected under 35 U.S.C. § 103(a) as being obvious from West et al. (USP 6,081,508) in view of Dieterman et al. (US Pat. Pub. No. US 2002/0013896).

**(vii) ARGUMENT**

### A. Rejection of Claims 1-11 as Unpatentable over West

To anticipate a claim, the reference must teach each and every element of the claim. MPEP § 2131 provides:

> A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. [. . .] The identical invention must be shown in as complete detail as is contained in the ... claim.

Claim 1 is independent. Claims 2-11 ultimately depend on claim 1. Claim 1 includes at least four limitations not disclosed, either inherently or expressly, by West. Claim 1 recites, "storing in the server system an available NAN list of NANs available for the client device to connect to the data network." The Examiner asserted that West discloses the claimed feature at Fig. 1 element 100 and Fig. 4 element 340. The rejection provides no further argument or explanation. West shows that element 100 is a remote computer and element 340 is a LAN (Figs. 1 and 4). A remote computer and a LAN are apparatuses, devices, and / or structures. As such, they can not teach a step of a method. That is, the cited apparatuses do not teach the claimed storing step. Because the cited portion of West does not disclose the claimed feature, the Examiner has not provided the required showing that West teaches what is recited in claim 1. As such, the rejection should be reversed.

Claim 1 further recites, "wherein the user NAN list comprises a subset of the available NAN list." The Examiner asserted that West discloses the claimed feature at 3:35-45 and Fig. 4 element 334. West, at 3:35-45 and Fig. 4 element 334, describes a management server which stores a dialing database and provides telephone access numbers from the dialing database to a remote computer. The cited portion of West does not disclose a user NAN list that is a subset of the available NAN List. Because the cited portion of West does not disclose the claimed feature, the rejection should be reversed.

Claim 1 further recites, "storing in the server system connection information about connecting from the NANs in the available NAN list to the data network." The Examiner asserted that West discloses the claimed feature at Fig. 1 element 140, Fig. 4 element 334, 3:35-45, and 3:5-7. West's Fig. 1 element 140 is a corporate communication system. The corporate communication system is made up of a local area network, communication related computers and routing devices coupled to the network. West's Fig. 4 element 334 is a management server. West, at 3:35-45, describes a management server which stores a dialing database and provides telephone access numbers from the dialing database to a remote computer. West, at 3:5-7, describes the remote computer accessing the dialing database to determine the set of access paths for communicating with the computing resource. A corporate communication system and a list of telephone access numbers stored in a management server do not teach the feature "storing in the server system <u>connection information</u> about connecting from the NANs in the available NAN list to the data network." The recited "connection information" includes the cost of the back end connection as well as the quality of the back end connection. Storing a list of telephone access numbers is not the same or analogous to storing cost and quality information about each NAN in an available NAN list. Because the cited portion of West does not disclose the claimed feature, the Examiner has not provided the required showing that West discloses what is recited in claim 1. As such, the rejection should be reversed.

Claim 1 further recites, "setting an order for selecting the NANs in the user NAN list based upon the connection information, wherein the order is set outside of the user's control." The Examiner asserted that West, at 2:58-63, discloses this feature. West, at 2:58-63, describes determining a set of access paths according to telephone charges associated with the location of the remote computer. The recited "connection information" includes the cost of the back end connection as well as the quality of the back end connection. Determining a set of access paths does not teach or suggest "<u>setting an order</u> for selecting the NANs in the user NAN list <u>based upon the connection information</u>, <u>wherein the order is set outside of the user's control</u>." Because the cited portion of West does not disclose the claimed feature, the Examiner has not met the required showing that West discloses what is recited in claim 1. As such, the rejection should be reversed.

By virtue of their dependency on claim 1, claims 2-11 are patentable over West. As such, the anticipation rejection of the claims 2-11 should be reversed.

**B. Rejection of Claims 12-25 and 30-32 as Unpatentable over West in view of Dieterman**

"To establish a *prima facie* case of obviousness, [. . .] the prior art reference (or references when combined) must teach or suggest all of the claim limitations." *MPEP 706.02(j).*

Claims 12 and 30 are independent. Claims 13-25 and 31-32 respectively depend on claims 12 and 30. Claim 12 includes at least three limitations not disclosed, taught or suggested by West or Dieterman.

Claim 12 recites, among other features, "storing in the online service provider server system an available NAN list of NANs available for the user's client device to connect to the data network, wherein the user NAN list comprises a subset of the available NAN list." The Examiner asserted that West teaches these features. These features are also recited in claim 1. For the same reasons as set forth in the arguments for claim 1, these features distinguish claim 12 over West. Dieterman fails to cure this deficiency. As such, the combination of cited art fails to teach or suggest the features claimed. Therefore, the rejection should be reversed.

Claim 12 further recites, "transmitting an identification of the NANs in the user NAN list from the client device to the online service provider server system." The Examiner asserted that this feature is taught at Figs. 2a-2c. No further argument or explanation was provided. West's Figs. 2a-2c illustrate interactive dialog boxes that allow the user to enter a username, password, and information as to where the user is dialing from. Interactive dialog boxes are unrelated to the claimed feature, "transmitting an identification of the NANs in the user NAN list from the client device to the online service provider server system." The user information gathered by the dialog boxes neither teaches nor suggests anything related or similar to a NAN list. Dieterman fails to cure this deficiency. As such, the combination of cited art fails to teach or suggest the features claimed.

Therefore, the rejection should be reversed.

To the extent that claim 30 includes similar limitations to claim 1, claim 30 is patentable over West in view of Dieterman for the same reasons that claim 1 is patentable. By virtue of their respective dependency on claims 12 and 30, claims 13-25 and 31-32 are patentable over West in view of Dieterman. As such, the obviousness rejection of the claims 13-25 and 30-32 should be reversed.


**CONCLUSION AND RELIEF**

In view of the foregoing, it is believed that all claims patentably define the subject invention over the prior art of record and are in condition for allowance. The undersigned requests that the Board overturn the rejection of all claims and hold that all of the claims of the above referenced application are allowable.

Respectfully submitted,

Date: June 25, 2007

M. Kala Sarvaiya, Reg. No. 58,912

SoCal IP Law Group LLP
310 N. Westlake Blvd., Suite 120
Westlake Village, CA 91362
Telephone: 805/230-1350
Facsimile: 805/230-1355
email: info@socalip.com

**(viii) CLAIMS APPENDIX**

The claims involved in this Appeal are as follows:

**1.** A method for maximizing qualities of a user network access number (NAN) list, the user NAN list comprising plural NANs, the NANs for use by a user's client device in connecting to a data network under control of a server system, the method comprising

storing in the server system an available NAN list of NANs available for the client device to connect to the data network, wherein the user NAN list comprises a subset of the available NAN list

storing in the server system connection information about connecting from the NANs in the available NAN list to the data network

connecting the client device to the server system

setting the NANs in the user NAN list based upon the available NAN list

setting an order for selecting the NANs in the user NAN list based upon the connection information, wherein the order is set outside of the user's control

disconnecting the client device from the server system.

**2.** The method for maximizing qualities of a user NAN list of claim 1 wherein the order setting step comprises associating ranking information with at least one NAN in the user NAN list.

**3.** The method for maximizing qualities of a user NAN list of claim 1 wherein the order setting step comprises specifying an actual sequential order of the NANs in the user NAN list.

**4.** The method for maximizing qualities of a user NAN list of claim 1 wherein the order setting step comprises providing a sequence list which identifies the order for using the NANs in the user NAN list.

**5.** The method for maximizing qualities of a user NAN list of claim 1 wherein the order setting step comprises providing the client device with connection information for the NANs in the user NAN list and an algorithm for selecting the NANs based upon the provided connection information.

**6.** The method for maximizing qualities of a user NAN list of claim 1 wherein

the NANs are for providing the client device with a connection to the data network through plural back end networks

each NAN is associated with a one of plural back end providers

each back end network is associated with one of the back end providers

the connection information includes a cost from the back end provider for the client device to utilize the back end network of the back end provider

the back end providers permit a connection through their back end networks to the client device under the authorization of the server system.

**7.** The method for maximizing qualities of a user NAN list of claim 1 wherein the connection information includes location information for the NANs in the available NAN list, the method further comprising

determining a location of the client device

determining an available local NAN list based upon the location of the client device and the location information for the NANs in the available NAN list

comparing the available local NAN list with the user NAN list to identify a good NAN in the available local NAN list which is not in the user NAN list

adding the good NAN to the user NAN list.

**8.** The method for maximizing qualities of a user NAN list of claim 7, wherein the location information for the NANs in the available NAN list comprises an area code.

**9.** The method for maximizing qualities of a user NAN list of claim 7, wherein before adding the good NAN to the user NAN list, asking the user for permission to add the good NAN to the user NAN list.

**10.** The method for maximizing qualities of a user NAN list of claim 7, further comprising

comparing the available local NAN list with the user NAN list to identify a bad NAN in the user NAN list which is not in the available local NAN list

deleting the bad NAN from the user NAN list.

**11.** The method for maximizing qualities of a user NAN list of claim 10, wherein before deleting the bad NAN from the user NAN list, asking the user for permission to delete the bad NAN from the user NAN list.

**12.** A method of setting an order for using network access numbers (NANs) in a user NAN list, the user NAN list comprising plural NANs, the NANs for use by the user's client device in connecting to a data network under control of an online service provider server system, wherein a connection from the client device to the data network comprises a front end portion and a back end portion, the front end portion comprising a first connection from the client device to a public switch, and the back end portion comprising a second connection from the public switch to a point of presence under control

of one of plural back end providers plus a third connection from the point of presence to the data network, wherein authorization for the back end provider to establish the back end portion is by the online service provider server system, and each NAN is associated with one of the back end providers, the method comprising

storing in the online service provider server system an available NAN list of NANs available for the user's client device to connect to the data network, wherein the user NAN list comprises a subset of the available NAN list

storing in the online service provider server system connection information for connecting from the NANs in the available NAN list to the data network, the connection information comprising at least one of (a) quality of connection information for the back end portion and (b) costs information for the back end portion

establishing a connection from the client device to the online service provider server system

transmitting an identification of the NANs in the user NAN list from the client device to the online service provider server system

setting an order for selecting the NANs in the user NAN list based upon at least one of (a) the stored quality of connection information for the back end portion and (b) costs information for the back end portion.

**13.** The method of ordering a user's network access number NAN list as set forth in claim 12 wherein there is a version code associated with the user NAN list for identifying a current version of the user NAN list, and the transmitting step comprises transmitting the version code from the client device to the online service provider server system.

**14.** The method of ordering a user's network access number NAN list as set forth in claim 12 wherein the transmitting step comprises transmitting the user NAN list from the client device to the

online service provider server system.

**15.** The method of ordering a user's network access number NAN list as set forth in claim 12 wherein the step of ordering is performed by the client device.

**16.** The method of ordering a user's network access number NAN list as set forth in claim 12 wherein the step of ordering is performed by the online service provider server system.

**17.** The method of ordering a user's network access number NAN list as set forth in claim 12, the order setting step comprising setting the order for selecting the NANs in the user NAN list based upon both the stored quality of connection information and the stored costs information.

**18.** The method of ordering a user's network access number NAN list as set forth in claim 17, wherein the connection information includes an identification of a back end provider.

**19.** The method of ordering a user's network access number NAN list as set forth in claim 12 wherein the available NAN list identifies a central office which serves each NAN, and the cost information for each NAN includes a cost of providing a connection from the respective central office to the data network.

**20.** The method of ordering a user's network access number NAN list as set forth in claim 12, wherein the stored quality of connection information comprises reliability data derived from historical quality-of-connection statistics associated with the NANs.

**21.** The method of ordering a user's network access number NAN list as set forth in claim 20, further including the client device providing the online service provider server system with quality of connection information, and the online service provider server system incorporating the quality of

connection information from the client device into the historical quality-of-connection statistics.


**22.** The method of ordering a user's network access number NAN list as set forth in claim 12 wherein the order setting step comprises associating ranking information with at least one NAN in the user NAN list.


**23.** The method of ordering a user's network access number NAN list as set forth in claim 12 wherein the order setting step comprises specifying an actual sequential order of the NANs in the user NAN list.


**24.** The method of ordering a user's network access number NAN list as set forth in claim 12 wherein the order setting step comprises providing a sequence list which identifies the order for using the NANs in the user NAN list.


**25.** The method of ordering a user's network access number NAN list as set forth in claim 12 wherein the order setting step comprises providing the client device with connection information for the NANs in the user NAN list and an algorithm for selecting the NANs based upon the provided connection information.


**30.** An online service provider server system for controlling a connection between a user's client device and a data network, wherein the user's client device attempts connection to the data network using network access numbers in a user network access number (NAN) list comprising plural NANs, the online service provider server system comprising

a first memory storing an available NAN list of NANs available for the client device to connect to the data network, wherein the user NAN list comprises a subset of the available NAN list

a second memory storing connection information about connecting from the NANs in the

available NAN list to the data network

computer program code which when executed causes the online service provider server system to perform operations including

connecting to the user's client device

setting the NANs in the user NAN list based upon the available NAN list

setting an order for selecting the NANs in the user NAN list based upon the connection information, wherein the order is set outside of the user's control

disconnecting from the client device.

31. The online service provider server system for controlling a connection between a user's client device and a data network of claim 30 wherein the online service provider server system associates ranking information with at least one NAN in the user NAN list.

32. The online service provider server system for controlling a connection between a user's client device and a data network of claim 30 wherein

the NANs are for providing the client device with a connection to the data network through plural back end networks

each NAN is associated with a one of plural back end providers

each back end network is associated with one of the back end providers

the connection information includes a cost from the back end provider for the client device to utilize the back end network of the back end provider

the back end providers permit a connection through their back end networks to the

client device under the authorization of the server system.

## (ix) EVIDENCE APPENDIX

No evidence has been submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title.  No other evidence has been entered by the examiner and relied upon by appellant in the appeal.

## (x) RELATED PROCEEDINGS APPENDIX

Since there are no applications currently being appealed that may directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal, there are no copies of decisions rendered by a court or the Board.